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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

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UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
JEAN-LOUIS BRAVET
and MARC MAURER

Appeal No. 2003-1478
Application No. 09/147,813

HEARD:
NOVEMBER 18, 2003

Before WALTZ¹, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not ready for decision on the merits of the rejections advanced by the examiner and thus, we remand the application to the examiner for appropriate action.

¹ Paul Lieberman, Administrative Patent Judge, who participated in the oral hearing for this appeal, is now retired. Therefore, Thomas A. Waltz, Administrative Patent Judge, has been added to the panel for participation in the subject decision. Reargument is not required. See In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

The examiner has rejected the pertinent appealed claims as follows:

Claims 40 through 45, 49, 52 and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer. Claims 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and Bier. Claims 48, 50 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and Oliver. Claims 53 through 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and Tatebayashi. Claims 44 and 63 through 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Motter in view of Hirmer and EP '417 and EP '348.

In the statement of the rejection in the Answer, the examiner found that Motter disclosed that, "[w]hile the examples disclosed by Motter et al. utilize a glass material as the transparent substrate, the reference clearly states that, 'an all-plastic structure' may be used for this purpose (col. 1 lines 36-38)." See Answer, page 3. Motter, however discusses, teaches, exemplifies and contains claims directed to all plastic structures. See column 6, line 59 through column 8, line 66, including Examples VI through IX and claims 4 through 8. The examples exemplify plastic sheets having scratch resistant coatings including sheets of polycarbonate. The examiner, however, has not discussed or made any evidentiary findings with respect to these pertinent portions of Motter. Furthermore, in the absence of any evidentiary findings by the examiner, we do not have appellants' views with respect to the aforesaid portion of Motter.

In addition, in one of the rejections before us, the examiner has cited and relied

upon EP '417 and EP'348 . We find that in the rejection of record over the European references, the discussion is limited and omits any reference to column and line for each of the references relied upon in the body of the rejection. See Answer, pages 6 and 7. Furthermore, the record before us contains only the original German language references alone in the absence of even English language abstracts attached thereto. See the Memorandum, of April 29, 2002 issued by the Deputy Commissioner for Patent Examination Policy directed to the subject, "Reliance upon abstracts and foreign language documents in support of a rejection."

The examiner should obtain and consider a complete translation of both European documents as relied upon by the examiner. The portions of the translations that support the examiner's position should be specifically referred to in any rejection employing those translated references and a copy of the translated documents forwarded to appellants.

Furthermore, the examiner should determine whether the record contains an English language copy of the R43 French standard. If not, a copy should be placed of record in the file in order to complete the record. This is so since claim 40 contains the limitation, "which meets French standard R43 for motor vehicle windows."

The response by the examiner should additionally point out where the specific limitations of any dependent claims argued separately by the appellants are found in the prior art relied upon in the rejection. We note that any prior art referred to that is not found in a statement of the rejection will not be considered. See, e.g., the reference to Charrier at page 12 of the answer.

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